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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/001,772	10/31/2001	Anand Subramanian	03485/100H799-US1	4306

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DARBY & DARBY P.C.
P.O. BOX 770
Church Street Station
New York, NY 10008-0770

EXAMINER	
ALVAREZ, RAQUEL	
ART UNIT	PAPER NUMBER
3688	

MAIL DATE	DELIVERY MODE
02/25/2009	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/001,772	SUBRAMANIAN ET AL.	
	Examiner	Art Unit	
	Raquel Alvarez	3688	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *14 January 2009*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *15,16,21,22 and 27-89* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *15,16,21,22 and 27-89* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date *1/14/09, 10/7/08, 8/18/08*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

1. This office action is in response to communication filed on 1/14/2009.

2. Claims 15, 16, 21, 22 and 27-89 are presented for examination.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 15, 16, 21, 22, 27-32, 33-36, 37-89 are rejected under 35 U.S.C. 103(a) as being unpatentable over Emens et al. (7,076,443 hereinafter Emens) in view of Herz et al. (5,835,087 hereinafter Herz).

With respect to claims 15, 16, 21, 22, 27-31, 33-35, 37-89, Emens teaches a system for delivering ads to a user operating a station connected to a distributed computer network (Abstract). An ad server which maintains the ads for the user at the station across the distributed network, the user station allowing the user to retrieve information containing content (Figure 3, 110); a data store that identifies a set of rules associated with each ad, the rules indicate a level of relevancy of the ad to the content of the information retrieved (Figure 3, 140); a match maker that accesses the content retrieved by the user, extracts the content according to its rules, parses the content of

the information by objects, free of information about the user (col. 4, lines 54-58) and targets an ad from the server to the content by applying the rules in the data store, and directly sends the targeted ad to the station for display with the content (Figure 3, 160 and corresponding text, specially col. 7, lines 11-17 which discloses **The search result items and associated product icons** are then displayed to the **browser 100**).

With respect to the newly added feature of the content being accessed in response to the submission of a URL by the user. Herz teaches on Figure 10, 1102 a user accesses a news site and the articles delivered to the users are based on the user's submission. It would have been obvious to a person of ordinary skill in the art at the time of Applicant's invention to have replaced Emens keyword search with the teachings of Herz of the content being accessed in response to the submission of a URL by the user because such a motivation would avoid **unwanted articles in an irrelevant or unexpected context** (Herz, col. 2, lines 43-53).

Claim 32 further recites that the performance is measured by click through rates of targeted ads. Official notice is taken that is old and well known in the computer related arts to monitor the amount of click through of an ad in order to measure how effective or attractive is the advertisement being presented. It would have been obvious to a person of ordinary skill in the art at the time of Applicant's invention to have included measuring the performance by click through rates of the ads in order to obtain the above mentioned advantage.

Claim 36 further recites that the content is classified is related to past consumption by users as a consequence of ads that were received and responded to. Official notice is taken that is old and well known to classify information related to past consumption of prior products or coupons redemption by the consumer in order to better target consequent ads to the users. It would have been obvious to a person of ordinary skill in the art at the time of Applicant's invention to have included the content being classified is related to past consumption by users as a consequence of ads that were received and responded to in order to obtain the above mentioned advantage.

Response to Arguments

Applicant argues that Emens doesn't teach displaying the requested content and the targeted ad together. The Examiner wants to point out that Emens teaches on col. 7, lines 11-18, "the request server 160 then builds a results page which contains the search result items, and if the search result item was flagged as a having a product match, a product icon or graphical user interface designator is also displayed for subsequent user selection. **The search result items and associated product icons are then displayed 98 to the browser 100**". As stated clearly from Emens above, the search result item is displayed along with the matching product icon. The product icon is a targeted advertisement based on the search result. Emens clearly teaches the recited claim limitation of "**directly send the targeted ad to the station for display with the content"** as stated above, in Emens, the targeted product icon is sent to the user station along with the search result (Emens col. 7, lines

11-18).

Applicant argues that in Emens the user has to click on the product icon and that in the instant invention the user does not, the Examiner wants to point out that the instant claims do not recite in what format the advertisements are presented to the user and therefore the claimed invention are met by Emens displaying the search results and targeted product icon to the user.

With respect the content being accessed in response to the submission of a URL by the user. The Examiner wants to point out that in Herz the user inputs the URL in order to receive content from a particular website and in Emens the user inputs keywords in order to receive the content. Modifying Emens to incorporate Herz teachings will produce a system wherein the user uses the URL instead of keywords to receive the content. This change is obvious and well known for users to use company's URL in order to obtain direct access to the information needed and therefore contrary to Applicant's arguments, the references do not teach away from each other.

In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See In re Keller, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); In re Merck & Co., 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

Applicant argues that the references do no teach a set of relevancy rules associated with each ad. The Examiner disagrees with Applicant because Emens clearly teaches on col. 4, lines 54-58, " The method of the instant invention follows an approach uniquely different from the e-commerce method of user profiling. Instead of

using user profiles to target advertisement, the resultant **search result items** from a search engine performing an Internet search are utilized. These **search result items** are **associated with similar or related advertisements**." The advertisements displayed to the users matches the search result item, as can be seen by above the ads are based on relevancy rules associated with the search results and not based on profiling or any information about the user or any intervening entities.

With respect to the official notice taken by the Examiner that monitoring the amount of click through of an ad and classifying information based on past consumption of prior products or coupons redemption by the consumer are well known. Applicant asserts that Emens or Herz do not teach such functions, but this is not relevant to the use of Official Notice. While applicant may challenge the examiner's use of Official Notice, applicant needs to provide a proper challenge that would at least cast reasonable doubt on the fact taken notice of. See MPEP 2144.03 where In re Boon is mentioned.

Conclusion

4. All claims are drawn to the same invention claimed in the earlier application and could have been finally rejected on the grounds and art of record in the next Office action if they had been entered in the earlier application. Accordingly, **THIS ACTION IS MADE FINAL** even though it is a first action in this case. See MPEP § 706.07(b). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within

TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no, however, event will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Point of contact

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Raquel Alvarez whose telephone number is (571)272-6715. The examiner can normally be reached on 9:00-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James w. Myhre can be reached on (571)272-6722. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Raquel Alvarez/
Primary Examiner, Art Unit 3688

Raquel Alvarez
Primary Examiner
Art Unit 3688

R.A.
2/22/2009